Paper No. 42

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ATSUNORI MORI, YOSHITAKA IKEDA,
KOICHI KINOSHITA and SHOHEI INOUE

Appeal No. 1997-3586
Application No. 08/240,811

ON BRIEF

Before KIMLIN, JOHN D. SMITH and WALTZ, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 9-13, all the claims remaining in the present application.

Claim 9 is illustrative:

9. A method for producing (S)-cyanohydrins by allowing hydrogen cyanide to react with aldehydes in the presence of a catalytic amount of cyclo-[(S)-leucyl-(S)-histidyl].

The examiner relies upon the following references as evidence of obviousness:

Jackson et al. (Jackson) (European patent application)	0,304,954	Mar. 1, 1989
Senno et al. (Sumo) (Japanese Kokai patent application)	1-172383	Jul. 7, 1989

The present application is a continuation of U.S. Application No. 07/595,886, filed October 1, 1990. Appellants took an appeal to this Board in the parent application, which appeal included the present claims on appeal and the same prior art now applied by the examiner. In a decision dated March 11, 1994 (Appeal No. 93-2768), the Board affirmed the examiner's rejection under 35 U.S.C. § 103. The present record includes declaration evidence not part of the prior appeal.

Appealed claims 9-13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sumo and Jackson.

Upon careful consideration of the opposing arguments presented on appeal, we will not sustain the examiner's rejection.

In the prior appeal the Board stated the following at page 4 of the opinion:

> Lacking in the present record is any testimony of one possessing skill in the relevant art which establishes that appellants' finding that the claimed catalyst produces stereoisomers of the products disclosed by Jackson would have been unexpected. . . . Furthermore, appellants have not demonstrated that the different enantiomer produced by the claimed catalyst is of significance and of practical advantage in the art. In re D'Ancicco, 439 F.2d 1244, 169 USPQ 303 (CCPA 1971). Simply put, the argument of appellants' counsel that the property of the claimed catalyst is unexpected is no substitute for factual objective evidence establishing such. In re DeBlauwe, 736 F.2d 699, 222 USPQ 191 (Fed. Cir. 1984); In re Pearson, 494 F.2d 1399, 181 USPQ 641 (CCPA 1974).

Also, regarding the method claims that are now again before us, the Board stated at page 5 of the decision that "it is incumbent upon appellants to present objective evidence of unexpected results to rebut the prima facie case of obviousness."

In essence, we find that appellants have met their burden of coming forward with objective evidence of nonobviousness for the claimed method on appeal. The Declaration and Supplemental Declaration of Dr. Gohfu Susukamo present credible evidence that one of ordinary skill in the art, based on the disclosure of Jackson, would not have expected that cyclo-[(S)-leu-(S)-his] would catalyze the formation of (S)-cyanohydrins, as presently claimed. While the examiner states

at page 8 of the Answer that the declaration evidence is not persuasive of unexpected results because the declarant simply presents "his personal analysis and criticism of the Jackson reference without presenting any facts that the teachings of the reference are unobvious to a person of ordinary skill," we agree with the position espoused in appellants' Brief that the declaration evidence sufficiently

demonstrates that the expressed opinion of the declarant is based

upon facts disclosed in the prior art.[1] As for the examiner's criticism that the declarant is an expert rather than one of ordinary skill in the art, it must be borne in mind that the examiner should not erroneously substitute his or her judgment for that of an established expert in the art. In re Zeidler, 682 F.2d 961, 967, 215 USPQ 490, 494 (CCPA 1982).

[1] Regarding the quoted portion of the Examiner's Answer, the examiner seems confused in referring to "presenting any facts that the teachings of the reference are unobvious to a person of ordinary skill" (emphasis added). Manifestly, the issue is the obviousness of the claimed invention, not the reference teachings.

Regarding the significance and practical advantage of preparing the claimed enantiomers, we find that such has been adequately established by appellants in their Brief.

In conclusion, based on the foregoing, the examiner's decision rejecting the appealed claims is reversed.

REVERSED

EDWARD C. KIMLIN Administrative Patent Judge	)	
JOHN D. SMITH Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
THOMAS A. WALTZ Administrative Patent Judge	)	

ECK:clm

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